

Appl. No. 10/026,092
Amdt. dated April 20, 2004
Reply to Office Action of January 20, 2004

Remarks

Applicant has amended claim 1 into appropriate English wherein the uprights are now defined in line 2, making reference thereto in line 4 correct. Also, "scaffolding" does not require "a" or "the" therefore, so antecedent therefor is not required.

Claims 1 and 5-10 are next rejected under 35 U.S.C. 102(b) as anticipated by UK Patent No. 2,157,755.

The Examiner states:

"UK reference shows and discloses a roof retaining apparatus comprising a framework including at least two angulated arms (no numbered), an upright (5,6) engaged to each arm, each upright having a top lateral sleeve (11), an upper cross member (4) and a lower cross member (16) engaged to and between uprights, said upper cross member having ends being slideable received by the sleeves (11) on the uprights, the arm having a flat portion being secured to a roof, the arm having a structure such as a brace (17) for mounting scaffolding thereover, and at least one net (18) stretched between and fixed to the uprights and cross members, wherein the net is removably secured to the upright and cross members by cooperating securement devices such as hooks which inherently via eyes (see lines 87-88) for providing a safety feature to prevent an operative from falling from the roof of a building."

This rejection is traversed.

The UK patent discloses:

"An anti-fall device for operatives working on the roof of a building comprises two frames connected by a hinge. The frames are provided preferably with feet, and each frame rests on a roof section on opposite sides of the ridge of the building. At least one frame is provided with an anti-fall barrier extending upwardly from the frame."

Applicant does not have or need 2 frames connected by hinges. Applicant also does not have or need frame

Appl. No. 10/026,092
Amdt. dated April 20, 2004
Reply to Office Action of January 20, 2004

sections resting on opposite sides of the ridge of a building.

Therefore, no anticipation exists. Here the Examiner is directed to the decisions in Structural Rubber Prod. Co., v. Park Rubber Co., 749 F.2d 707, 223 USPQ 1264 (Fed. Cir. 1984):

"Anticipation can only be established by a single prior art reference which discloses each and every element of the claimed invention. Anticipation is not shown even if, ... the differences between the claims and the prior art references are "insubstantial" and the missing elements could be supplied by the knowledge of one skilled in the art."

And Richardson v. Suzuki Motor Co., Ltd., 868 F.2d 1226, 9 USPQ2d 1913 (Fed. Cir. 1989):

(3) "Every element of the claimed invention must be literally present, arranged as in the claim."

Next, the Examiner rejects claims 1, 5-8 and 11 under 35 U.S.C. 102(b) as anticipated by Elkins.

The Examiner states:

"Elkins et al. shows and discloses a roof retaining apparatus comprising a framework including at least two angulated arms (16) each having a flat portion (38) being mounted to a roof, an upright (40) engaged to the flat portion of each arm, each upright having a top and bottom lateral sleeve (48,49), an upper cross member (20) and a lower cross member (22 or 24) engaged to and between uprights, said cross members each having ends being secured to the sleeves of the uprights by pins (44,50), the arm having a structure such as a brace (41) for mounting scaffolding thereover, and at least one net (28) stretched between and fixed to the uprights and cross members by suitable securement device."

Once again applicant submits that the crowd control barrier is not analogous art to a roof safety device. Here see Ex parte Lee, 31 U.S.P.Q.2d 1105, 1110 dissent n.1 (B.P.A.I. 1993):

"Evidence may be introduced to overcome a rejection under 35 U.S.C. §102, e.g., evidence demonstrating that an applied reference is nonenabling, to show that a recited

Appl. No. 10/026,092
Amdt. dated April 20, 2004
Reply to Office Action of January 20, 2004

characteristic is not inherent in a prior art article, or to show that an applied reference is not actually valid prior art under 35 U.S.C. §102."

And Lacotte v. Thomas, 758 F.2d 611, 225 U.S.P.Q. 633 (Fed. Cir. 1985):

"To decide whether prior art in an analogous field is pertinent, the problems confronting a person skilled in the subject art must be considered to decide whether such a person would have looked to art in other fields of endeavor to solve those problems. It is a question of fact for a jury to decide whether another field of art is sufficiently analogous to the art with which each patent is concerned that a person with a problem in the latter field would look to the former field to adopt solutions to the problem devised there. If the reference is not within the field of the inventor's endeavor, one looks at whether the field of the reference is reasonably pertinent to the problem the inventor is trying to solve."

Elkins CANNOT accommodate mounting onto a pitched roof because the knee brace thereof is set for 90° relationship between the vertical portion of the barrier and the legs thereof. If the barrier were positioned at any other angularity it would be useless for crowd control.

Here the Examiner is directed to the decisions in RCA Corp., v. Applied Digital Data Sys., 730 F.2d 1440, 221 USPQ 385 (Fed. Cir. 1984):

"Anticipation is determined by comparison of the reference with the claims. Claim elements in means-plus-function format cannot be met by an element in a reference that performs a different function."

In re Bond, 910 F.2d 831, 15 USPQ2d 1566 (Fed. Cir. 1990):

"'For a prior art reference to anticipate in terms of 35 U.S.C. § 102, every element of the claimed invention must be identically shown in a single reference'... These elements must be arranged as in the claim under review,..."

Pac-Tec, Inc., v. Amerace Corp., 903 F.2d 796, 14 USPQ2d 1871 (Fed. Cir. 1990):

Appl. No. 10/026,092
Amdt. dated April 20, 2004
Reply to Office Action of January 20, 2004

"In determining anticipation, ... functional language, preambles, and language in "whereby," "thereby," and "adapted to" clauses cannot be disregarded."

And In re Benno, 226 USPQ 683 (Fed. Cir. 1985):

"In dismissing Dante as a reference, the court pointed out that Dante did not even hint at the problem the appellants sought to solve. Dante would not even have encountered the problem because it would not have appeared in what he was doing."

Clearly there is no anticipation again.

Next, claims 1-7, 9, 11, 14 and 15 are rejected under 35 U.S.C. 103(a) as unpatentable over Probst in view of UK '755.

The Examiner states:

"Probst shows and discloses a roof retaining apparatus comprising a framework including at least two angulated arms, each arm having a flat portion (6) having a plurality of angular slots (10) at a free end of the flat portion to engage with fasteners such as nails (9) for securing the arm to a roof (8), each arm having vertical sleeve (15) and an upstanding flange (21), the upstanding flange (21) forming a channel-shaped bracket that provides a structure for mounting scaffolding (22) thereon, an upright (24) having a lower end being received and engaged by the vertical sleeve (15) to each of the arms, each upright (24) having at least a top and bottom lateral sleeves (26,28), an upper cross member (27) and a lower cross member (29) each having ends being slideable received by the sleeves (26 or 28) on two uprights respectively, said each sleeve having bores receiving with a pin (30) therein to engage and secure the ends of cross members to the uprights."

Probst fails to define the roof retaining apparatus including a net stretched between and fixed to the uprights and the cross members as claimed. UK reference teaches a roof retaining apparatus comprising a framework including uprights and cross members, and a net having securement device such as hooks (19,20) along the edges

Appl. No. 10/026,092
Amdt. dated April 20, 2004
Reply to Office Action of January 20, 2004

of the net to hang the net pivoting from an upper cross member and rest against a lower cross member. It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the roof retaining apparatus of Probst having a net hooked and stretched between the cross members and fixed to the framework as taught by UK reference for providing a safety device with additional safety features for prevention an operative falling from the roof of the building."

This rejection is traversed.

Combining the teachings of the UK patent with those of Probst is illogical. Why would the simplified version of Probst be incorporatable into the complex UK structure. Such combination would defeat the purpose of both and there is no motivation or suggestion to go through the machinations of the Examiner's mind to create such combination, which would require extensive modification of both prior art patents - without motivation.

Taking of bits and pieces from various references to fill applicant's mold comprises use of illegal hindsight reconstruction and the rejection cannot stand.

Here the Examiner is directed to the decisions in Rockwell International Corp v. United States, 147 F.3d 1358, 47 U.S.P.Q.2d 1027, 1032 (Fed. Cir. 1998):

"In order to render a claimed apparatus or method obvious, the prior art must enable one skilled in the art to make and use the apparatus or method."

Uniroyal Inc. v. Rudkin-Wiley Corp., 837 F.2d 1044, 5 U.S.P.Q.2d 1434 (Fed. Cir. 1988):

"A proper combination of references requires the presence of a teaching or suggestion in any of the references, or in the prior art as a whole, that would lead one of ordinary skill in the art to make the combination. The mere fact that a device or process utilizes a known scientific principle does not alone make that device or process obvious."

(4) "A proper combination of references requires the presence of a teaching or suggestion in any of the references,

Appl. No. 10/026,092
Amdt. dated April 20, 2004
Reply to Office Action of January 20, 2004

or in the prior art as a whole, that would lead one of ordinary skill in the art to make the combination. The mere fact that a device or process utilizes a known scientific principle does not alone make that device or process obvious."

Claims 8 and 12 are next rejected under 35 U.S.C. 103(a) as unpatentable over Probst in view of UK '755 and Pedley.

The Examiner states:

"Claims are considered to be met by Probst combined with UK reference as explained and applied above rejections except that either Probst or UK reference does not define the roof retaining device including the upright and cross members having cooperating securement devices comprise eyes for cooperatively receiving the securement devices along the edges of a net for detachably securing the net between the cross members. Pedley teaches a roof safety device comprising a framework including uprights (15) and cross members (14), and a net (1) detachably mounted to the framework, wherein the net (1) includes hooks (24) providing securement devices mounted along the edges of the net, the framework including eyes (25) mounted on the uprights each having a plurality of eyes providing cooperative securement device for cooperatively receiving the hooks of the net for detachably mounted the net to the framework. It would have been obvious to one ordinary skill in the art at the time the invention was made to modify the roof retaining apparatus of Probst combined with UK reference having the framework providing with cooperating securement devices such eyes to cooperatively receive the securement device such as hooks formed along the edges of the net as taught by Pedley, as a well know removable cooperative mounting mechanism, for detachably securing the net to the framework to provide a safety device to the roof retaining apparatus."

Pedley discloses a safety net having a tightening chain at one corner. The exact configuration of the safety net is disclosed.

The claims rejected under the combination depend from claim 1 and incorporate the limitations thereof. Therefore, the mere fact that a particular configuration of a net is known somewhere does nothing with regard to claiming applicant's invention obvious.

Appl. No. 10/026,092
Amdt. dated April 20, 2004
Reply to Office Action of January 20, 2004

Here see Interconnect Planning Corp., v. Feil, 774 F.2d 1132, 227 USPQ 543 (Fed. Cir. 1985):

"It is error to reconstruct the patentee's claim as a "blueprint." When prior art references require selective combination to render obvious a subsequent invention, there must be some reason for the combination other than the hindsight obtained from the invention itself. It is critical to understand the particular results achieved by the new combination."

In re Fine, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988):

"One cannot use hindsight reconstruction to pick and choose among isolated disclosures in the prior art to deprecate the claimed invention."

And In re Gordon, 733 F.2d 900, 221 USPQ 1125 (Fed. Cir. 1984):

"The fact that a prior art device could be modified so as to produce the claimed device is not a basis for an obviousness rejection unless the prior art suggested the desirability of such a modification."

Next, the Examiner rejects claims 12, 13, 16 and 17 under 35 U.S.C. 103(a) as unpatentable over Probst in view of UK '755 and further in view of Murray.

The Examiner states:

"Claims are considered to be met by Probst combined with UK reference as explained and applied above rejections except that either Probst or UK reference does not define the sleeve, the upright, and the cross member end flanges of the apparatus having bores being aligned together and a pin being engaged through the aligned bores for securing the upright and the cross member together. Murray teaches a safety device comprising an arm being secured to a building roof, a vertical sleeve (32) latterly mounted on the arm, and an upright post (12) having lower end being received into the vertical sleeve (32), wherein the vertical sleeve (32) and the lower end of the upright post (12) having bores being aligned each other and a pine (34) being engaged through the aligned bores for securing the upright post to the vertical

Appl. No. 10/026,092
Amdt. dated April 20, 2004
Reply to Office Action of January 20, 2004

sleeve. It would have been obvious to one ordinary skill in the art at the time the invention was made to modify the roof retaining apparatus of Probst combined with UK reference having the upright, the cross member, and the sleeves respectively having bores aligned each other to receive a pin passed therethrough as taught by Murray, as an old and well know connecting mechanism, instead of having a pin to engage an inside member of Probst for removably and adjustably mounting two structural elements together."

Again, Murray discloses:

"A safety rail system for installation about the perimeter of a rooftop work site comprises a plurality of stanchion-supporting bases for attachment to existing building structure, a plurality of stanchions removably held by the bases and having cable-receiving links thereon, and a pair of wire rope cable safety rails supplied by a pair of winches fixed to at least one of the stanchions. The bases include a pair of plate members connected by a hinge for adjustable attachment to a vertical wall surface of the building and another structural surface forming an edge with the vertical wall surface. A vertically extending sleeve is fixed to the plate member which attaches to the vertical wall surface of the building for slidably receiving a bottom portion of a stanchions, and a transversely extending locking pin is used to retain the bottom portion of the stanchion within the sleeve. The safety rail cables are unwound from their respective winches and connected to the stanchions using the cable receiving links, then tensioned using the winches."

The combination the Examiner presents again is unworkable and again destroys the "teachings as a whole" of each piece of prior art. Still further, there is again NO MOTIVATION in any of the prior art to perform the combination the Examiner finds obvious. This rejection cannot stand as it also is not bottomed on a solid evidentiary base.

Here the Examiner is directed to Hartness International, Inc., v. Simplimatic Engineering Co., 819 F.2d 1100, 2 USPQ2d 1826 (Fed. Cir. 1987):

Appl. No. 10/026,092
Amdt. dated April 20, 2004
Reply to Office Action of January 20, 2004

"In determining obviousness, "the inquiry is not whether each element existed in the prior art, but whether the prior art made obvious the invention as a whole for which patentability is claimed."

Datascope Corp., v. SMEC, Inc., 776 F.2d 320, 227 USPQ 838 (Fed. Cir. 1985):

"Whether prior art disclosures could physically be substituted in a combination like that claimed in the patent is irrelevant in determining obviousness under Section 103."

Finally, it is peculiar that such a large plurality of diverse prior art has been depended upon by the Examiner to attempt to deprecate claims directed to a simple, efficient, easy to use structure. Clearly the need to cite such a vast amount of art upholds applicant's claim that the invention as a whole is neither anticipated by or obvious from any of the cited art.

Here see the decisions in In re Wright, 848 F.2d 1216, 6 USPQ2d 1959 (Fed. Cir. 1988):

(2)"The PTO erred in arguing that "if it is obvious to combine the teachings of prior art references for any purpose, they may be combined in order to defeat patentability of the applicant's admittedly new structure" and that "it is irrelevant that [the claimed] structure was for a purpose, and has properties, that are neither obtainable from the prior art structures, nor suggested in the prior art."

(4)"[I]t is the invention as a whole that must be considered in obviousness determinations. The invention as a whole embraces the structure, its properties, and the problem it solves."

Appl. No. 10/026,092
Amdt. dated April 20, 2004
Reply to Office Action of January 20, 2004

An earnest endeavor has been made to place this application in condition for allowance and an early action to that effect is awaited.

Respectfully submitted,

A handwritten signature in cursive script that reads "Kajane McManus". The signature is written in dark ink and is positioned above the printed name and registration number.

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